

As the Examiner now recognizes, *Glaze, et al.* failed to offer any suggestion or motivation to combine its teachings with the teachings of *Gale*. Indeed, *Glaze, et al.* makes no mention or otherwise promotes any particular technique for attaching the snorkel to the housing.

In the Office Action of November 5, 2002, the Examiner now seeks to supply this missing suggestion or motivation through another reference, *Danjou, et al.* However, *Danjou, et al.* suffer from the same deficiency as *Glaze, et al.* That is, there is no suggestion or motivation to combine the teachings of *Danjou, et al.* with the particular method of welding offered by *Gale*. Moreover, there is no reason or suggestion to combine *Glaze, et al.* with *Danjou, et al.* in the first instance. Instead, the Examiner simply assumes such suggestion or motivation. As acknowledged in Applicant's background of invention, it is certainly well known to weld a blank surface to a differential housing. However, it is not known to use the particular method of welding taught by the present invention. Neither *Danjou, et al.* nor *Glaze, et al.* provide a suggestion or motivation to use the specific welding technique taught by *Gale*. Accordingly, claim 1-3 and 9-20 are allowable over the cited references.

The Examiner further rejected claims 4 and 5 under 35 U.S.C. §103(a) as unpatentable over *Glaze, et al.* in view of *Danjou, et al.* and *Gale* and further in view of *Cox*. These claims, which depend upon claim 1, are allowable for the reasons stated above. In addition, the Examiner's reliance on the fourth reference, *Cox*, is improper. Indeed, contrary to the Examiner's position, *Cox* does not teach a process of welding in which surfaces are brought together, then spread apart, and then brought together again until the surfaces are welded. Rather, *Cox* teaches simply bringing the two surfaces

together. (Column 3, lines 65-75, column 4, lines 1-14). There is no teaching within *Cox* of “creating another electrical potential between the surfaces, moving the surfaces in proximity to each other to affect the electrical discharge between the surfaces, and applying the surfaces together,” as required by claim 4. *Cox* teaches only “an initial current flow between the rails 14b and 14c.” (Column 3, lines 74-75).

Applicant also notes that the method of welding taught by *Cox* relates to railroad tracks. The *Cox* welding technique, which includes the use of a trailer 16, to hold the blank surfaces together is not analogous art for welding a differential housing to a blank surface. For this additional reason, claim 4 and its dependent, claim 5, are allowable over the cited references. In sum, even if *Cox* were properly combinable with the other references, the claims still are not met. However, *Cox* is not properly combinable.

The Examiner also rejected claims 1, 6 and 8-20 under 35 U.S.C. §103(a) as unpatentable over *Glaze, et al.* in view of *Danjou, et al.* and *Larsen*. Once again, the Examiner fails to identify any suggestion or motivation to combine *Glaze, et al.* and *Danjou, et al.* with the particular welding methods taught by *Larsen*. Indeed, while *Danjou, et al.* may suggest welding blank surfaces to a differential housing, it does not suggest or provide any motivation to use the particular type of method of welding. The Examiner’s reliance of *Danjou, et al.* to provide motivation or suggestion for both friction welding and welding by electricity indicates that *Danjou, et al.* itself does not specifically suggest or provide motivation for its combination with the particular type of welding. Accordingly, while *Danjou, et al.* suggest welding generally, none of the cited references offer motivation or suggestion for any particular type of welding as taught by

the present invention. Therefore, claims 1, 6 and 8-20 are allowable over the cited references.

The Examiner rejected claims 1, 6, 7, and 9-20 pursuant to 35 U.S.C. §103(a) as being unpatentable over *Glaze, et al.* in view of *Danjou, et al.* and *Brownell, et al.*, *Walker, et al.*, or *Mahoney, et al.* By the Examiner's own admission, "*Glaze* does not teach how the differential housing surface and snorkel are fastened together" and "*Danjou, et al.* do not teach a particular method of welding." Nothing within the five references cited by the Examiner suggests or provides motivation for either the teachings of *Glaze, et al.* or *Danjou, et al.* to be combined with any particular method of welding. The Examiner contends that such motivation is provided by the general teaching of welding blank surfaces to a differential housing. Yet, within the cited references there is no suggestion or motivation to use the particular technique taught by the present invention.

Claims 1-3 and 11-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Stewart, et al.* in view of *Gale*. The Examiner acknowledges that *Stewart, et al.* does not teach a specific welding method. Again, there is no motivation or suggestion to use the particular welding technique of the present invention in the cited references, although there is certainly a suggestion to weld the surfaces together. Applicant has already acknowledged welding generally to be prior art in its background of the patent. Simply, the particular claimed technique for welding is inventive.

The Examiner rejected claims 4 and 5 under 35 U.S.C. §103(a) as unpatentable over *Stewart, et al.* in view of *Gale* as applied to claims 1-3, and 11-18 above, and further in view of *Cox*. As explained above, *Cox* is non-analogous art. Therefore, claims 4 and 5 are allowable over the cited reference.

The Examiner rejected claims 1, 6, 8 and 11-18 under 35 U.S.C. §103(a) as unpatentable over *Stewart, et al.* in view of *Larsen*. Neither *Stewart, et al.* nor *Larsen* teach the specific welding technique taught by the present invention. As the Examiner acknowledges, *Stewart, et al.* does not teach “a specific welding method.” Accordingly, there is no motivation or suggestion to combine *Stewart, et al.* with any specific welding technique. The combination of *Stewart, et al.* and *Larsen* is therefore improper. Claim 1, 6, 8, and 11-18 are allowable over the cited references.

The Examiner rejected claims 1-3, 9 and 11-19 pursuant to 35 U.S.C. §103(a) as unpatentable over *Danjou, et al.* in view of *Gale*. Again, *Danjou, et al.* does not teach a specific welding method. It also does not provide motivation or suggestion to use any specific welding method. Therefore, its combination with *Gale* is improper and claims 1-3, 9 and 11-19 are allowable over the cited reference.

Claims 4 and 5 were rejected by the Examiner as unpatentable over *Danjou, et al.* in view of *Gale* as applied to claims 1-3, 9 and 11-19 above, and further in view of *Cox*. Again, *Cox* does not teach all of the limitations of claims 4 and 5. Therefore, these claims are allowable over the cited reference.

The Examiner rejected claims 1, 6, 8, 9 and 11-19 as obvious over *Danjou, et al.* in view of *Larsen*. *Danjou, et al.* do not teach a specific welding method. Neither *Danjou, et al.* nor *Larsen* provide motivation or suggestion to employ the particular welding technique of *Larsen* in the particular field of invention of *Danjou, et al.* Therefore, claims 1, 6, 8, 9 and 11-19 are allowable.

Claims 1, 6, 7, 9 and 11-19 were rejected under 35 U.S.C. §103(a) as unpatentable over *Danjou, et al.* in view of *Brownell, et al.*, *Walker, et al.* or *Mahoney, et al.* For the reasons stated above, there is no suggestion or motivation to combine *Danjou, et al.* with any particular welding technique, such as the techniques taught by *Brownell, et al.*, *Walker, et al.*, and *Mahoney, et al.* There is no specific motivation to apply these techniques to the field of invention. Accordingly, claims 1, 6, 7, 9 and 11-19 are allowable.

The Examiner rejected claims 1 and 9-11 as unpatentable over Applicant's admitted prior art. The Examiner contends that arc welding of the differential housing and snorkel together meets the limitations of the foregoing claims. Applicant notes that claim 1 specifically requires: "generating heat from at least one of these surfaces at their interface sufficient to weld the surfaces together." This limitations is not taught by the prior art. Specifically, the heat from the prior art is not generated by the surfaces but instead generated by the arc welder. In contrast, whether by friction welding or by creating an electric potential between the surfaces, the inventive welding technique generates or creates heat rather than transmits heat between the surfaces. Therefore, claim 1 and 9-11 are allowable over the cited reference.

In sum, all claims are allowable.

Respectfully submitted,

CARLSON, GASKEY & OLDS

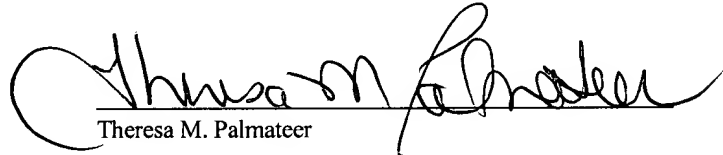
By: 

Anthony P. Cho
Registration No. 47,209
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

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